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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,170	02/18/2004	James W. Cornett	2003P02869US01	1812

7590 11/26/2008
Elsa Keller
SIEMENS CORPORATION
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EXAMINER

BENOIT, ESTHER

ART UNIT	PAPER NUMBER
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2442

MAIL DATE	DELIVERY MODE
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11/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/781,170	CORNETT ET AL.	
	Examiner	Art Unit	
	ESTHER BENOIT	2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/4/2004, 4/8/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-29 are pending in this application.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
3. The information disclosure statements filed 8/4/2004 and 4/8/2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because reference citations are incomplete. There is missing information such as page numbers, city/country where published, and etc. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 27 is rejected under 35 U.S.C. 101 because it is directed to a non-statutory subject matter. The term “wizard” in this claim is used vaguely and can be defined as “software adaptable to guide a user through predetermined sequential steps of a task” as found in the specification. Claims directed to software that are not embodied on a statutory physical computer readable media are not patentable.

Claim Objections

5. Claims 3 and 4 objected to because of the following informalities: Claim 3 and 4 are identical to one another, which both depend from claim 1.
Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-8, 12, and 17-23 are rejected under 35 U.S.C. 102(b) as being unpatentable over Jones et al. (WO 0035238 A) as applied in the International Search Report submitted by the applicant.

8. Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by McNutt (US 6,925,158 B2)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claim 1, McNutt discloses automatically enforcing, via a wizard, user compliance with a plurality of predetermined steps for a computer-assisted configuration of the network interface device, the computer-assisted configuration relating to an OSI transport layer or above; and providing at least one setting to the network interface device (Col. 4, lines 7-33 and Col. 5, lines 1-3)

With respect to claim 2, McNutt discloses requesting, from a user, the at least one setting for the network interface device (Col. 5, lines 1-3)

With respect to claim 3, McNutt discloses receiving the at least one setting for the network interface device (Col. 5, lines 1-13)

With respect to claim 4, McNutt discloses receiving the at least one setting for the network interface device (Col. 5, lines 1-13)

With respect to claim 5, McNutt discloses receiving a count of network connections for the network interface device (Col. 5, lines 1-13)

With respect to claim 6, McNutt discloses receiving a type for at least one network connection to the network interface device (Col. 5, lines 1-13)

With respect to claim 7, McNutt discloses determining the at least one setting for the network interface device (Col. 5, lines 1-13)

With respect to claim 8, McNutt discloses configuring the network interface device with the at least one setting (Col. 5, lines 1-13)

With respect to claim 9, McNutt discloses receiving a setting of a logical position of the network interface device relative to the programmable logic controller (Col. 5, lines 1-13)

With respect to claim 10, McNutt discloses receiving a Q-address used by an input/output module attached to the programmable logic controller, the input/output module further couplable to the network interface device (Col. 5, lines 1-13)

With respect to claim 11, McNutt discloses verifying the at least one setting for the network interface device (Col. 5, lines 1-13)

With respect to claim 12, McNutt discloses wherein the network interface device is adaptable to communicatively couple the programmable logic controller to an Ethernet network (Col. 5, lines 1-13)

With respect to claim 13, McNutt discloses wherein the network interface device is adaptable to communicatively couple the programmable logic controller to the Internet (Col. 5, lines 1-13)

With respect to claim 14, McNutt discloses wherein said plurality of predetermined steps are adaptable to receive at least one e-mail client configuration setting (Col. 5, lines 1-13)

With respect to claim 15, McNutt discloses wherein said plurality of predetermined steps are adaptable to receive at least one FTP client configuration setting (Col. 5, lines 30-31)

With respect to claim 16, McNutt discloses wherein said plurality of predetermined steps are adaptable to receive at least one FTP server configuration setting (Col. 5, lines 30-31)

With respect to claim 17, McNutt discloses wherein said plurality of predetermined steps are adaptable to receive at least one HTTP server configuration setting (Col. 9, lines 25-36)

With respect to claim 18, McNutt discloses wherein said plurality of predetermined steps are adaptable to receive at least one FTP server login services setting (Col. 5, lines 30-31)

With respect to claim 19, McNutt discloses wherein said plurality of predetermined steps are adaptable to receive at least one secure HTTP server login services setting (Col. 9, lines 25-36)

With respect to claim 20, McNutt discloses wherein said plurality of predetermined steps are adaptable to validate an FTP server address (Col. 5, lines 30-31)

With respect to claim 21, McNutt discloses wherein said plurality of predetermined steps are adaptable to receive at least one SMTP client configuration setting (Col. 8, lines 30-39)

With respect to claim 22, McNutt discloses wherein said plurality of predetermined steps are adaptable to configure an e-mail message to at least one user (Col. 5, lines 1-13)

With respect to claim 23, McNutt discloses wherein said plurality of predetermined steps are adaptable to validate an e-mail server address (Col. 5, lines 1-13)

With respect to claim 24, McNutt discloses wherein said network interface device is adaptable to communicate at least one programmable logic controller administration setting to the programmable logic controller (Col. 5, lines 1-13)

With respect to claim 25, McNutt discloses wherein said network interface device is adaptable to communicate process data from the programmable logic controller to a network (Col. 5, lines 1-13)

With respect to claim 26, McNutt discloses wherein said plurality of predetermined steps comprises a help utility (Col. 5, lines 1-13)

With respect to claim 27, McNutt discloses a wizard adaptable to configure a network interface device couplable to a programmable logic controller, said wizard comprising: an input processor adapted to sequentially prompt a user for at least one setting for configuring the network interface device at an OSI transport layer or above; and an output processor adapted to provide the at least one setting from the wizard to the network interface device (Col. 4, lines 7-33 and Col. 5, lines 1-3)

With respect to claim 28, McNutt discloses a network interface device adaptable to communicatively couple a programmable logic controller to a network; and a wizard comprising a plurality of predetermined steps adapted to configure said network interface device at an OSI transport layer or above (Col. 4, lines 7-33 and Col. 5, lines 1-3)

With respect to claim 29, McNutt discloses providing a plurality of predetermined steps adapted to sequentially prompt a user for at least one setting for configuring the

Art Unit: 2442

network interface device at an OSI transport layer or above; and providing a plurality of predetermined steps adapted to provide the at least one setting from the wizard to the network interface device (Col. 4, lines 7-33 and Col. 5, lines 1-3)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 9-11, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (WO 0035238 A) as applied in the International Search Report submitted by the applicant.

11. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaw et al. (WO 9853581 A) as applied in the International Search Report submitted by the applicant. In this same International Search Report, Claims 13 and 15 are also rejected under Lumpp et al. (*Virtual Java devices. Integration of fieldbus based systems in the Internet*, Sept. 1998)

12. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sistanizadeh et al. (US 6,101,182 A) as applied in the International Search Report submitted by the applicant. In this same International Search Report, Claims 9-11 are also rejected under Caswell et al. (WO 0130130 A)

Art Unit: 2442

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson et al. (US 6,324,681 B1) as applied in the International Search Report submitted by the applicant.

14. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over (*Simple Object Access Protocol 1.1*, November 2002) as applied in the International Search Report submitted by the applicant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esther Benoit whose telephone number is 571-270-3807. The examiner can normally be reached on Monday through Friday between 7:30 a.m and 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2442

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

E.B.

November 18, 2008

/Andrew Caldwell/

Supervisory Patent Examiner, Art Unit 2442